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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,366	01/25/2002	Gerard Malle	2350-94	7627

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EXAMINER
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TRAN, SUSAN T

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 09/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/055,366

Applicant(s)

MALLE ET AL.

Examiner

Susan Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40-76 is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-11 and 13-39 is/are rejected.
- 7) ☒ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt is acknowledged of applicant's Request for Extension of Time, Change of Address, Amendment, and Terminal Disclaimer filed 06/30/03.

#### ***Terminal Disclaimer***

The terminal disclaimer filed on 06/30/03 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US 6,361,767 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7, 11, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham et al. 3,892,845.

Cunningham teaches a method for adjusting hair comprising applying to the hair combination of keratin disulfide reducing agent and dye reducing agent (column 2, lines 18-66). The time of application ranges from about 15 minutes to 1 hour (column 3, lines 1-20).

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Cunningham does not teach the reactive of disulphide bonds on the surface of the fiber to a depth of less than 10  $\mu\text{m}$ . However, since Cunningham uses the same keratin disulfide reducing agent and the same application time to obtain the desired hair color shade without impairing the mechanical properties of the hair (column 1, lines 45-50), it is the position of the examiner that said limitation is clearly inherent. Thus, it would have been obvious for one of ordinary skill in this art to, by routine experimentation optimize Cunningham's composition with the expectation of at least similar result, because Cunningham teaches a method for fixing hair using the same materials and conditions.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham et al., in view of Bailey et al. WO 96/03966.

Cunningham is relied upon for the reason stated above. The reference is silent as to the specific active agent in combination with the reducing agent.

Bailey teaches method for styling hair comprising applying to the hair composition comprises reducing agent and hydrophobic groups compound (pages 3-4, and 6). Thus, it would have been obvious for one of ordinary skill to combine Cunningham's composition with the hydrophobic compounds of Bailey, because the references teach the advantageous results in combining reducing agent and active agent such as hydrophobic compound to treat hair fibers.

Claims 8-11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham et al., in view of Shimura et al. EP 0 331 750.

Cunningham is relied upon for the reasons stated above. The reference is silent as to the teaching of the phosphine formula recited in claim 8. However, Cunningham teaches the exact same phosphine compound recited in claims 9 and 10, e.g., tris-(hydroxyalkyl) phosphine.

Shimura teaches a method for treating hair fibers comprising applying to the hair composition comprising hydroxyalkylphosphine compound having formula (1), other additives, and pH adjusting agent to obtain pH ranges from 3-7 (pages 3-4). Hence, it would have been obvious for one of ordinary skill to modify Cunningham's composition using the hydroxyalkylphosphine compound in view of the teachings of Shimura, because the references teach the advantageous results in the use of hydroxyalkylphosphine compound for the same purpose, e.g., treating hair fibers.

### ***Response to Arguments***

Applicant's arguments filed 06/30/03 have been fully considered but they are not persuasive.

Applicant argues that the Cunningham patent using the keratin reducing agent only to permit the dye reducing agent to reach its target, and therefore, Cunningham does not disclose or suggest the possibility of using the reducing agent to generate reactive sites on the keratin fibers for covalently fixing at least one active compound. Contrary to the applicant's argument, the transitional phrase "comprising of" in the claims does not

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exclude the use of the dye reducing agent taught by Cunningham. Cunningham teaches the use of the same keratin disulfide reducing agent and the same application time to obtain the desired hair color shade without impairing the mechanical properties of the hair (column 1, lines 45-50). It is noted that if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Applicant argues that the cited art, individually or in combination, fails to disclose or suggest hair keratin treatment wherein the keratin fibers are reduced only on their surface, i.e., at a depth less than 10  $\mu\text{m}$ . According to the above argument regarding Cunningham, the patent teaches a similar method using the claimed materials and conditions, the burden is shifted to the applicant to present data showing that the keratin reducing agent taught by Cunningham does not reduce the disulphide bonds on the surface of the hair at a depth less than 10  $\mu\text{m}$ . Furthermore, it is noted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

***Claims allowable***

Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 40-76 are allowed.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600